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OFFICE OF PETITIONS

Applicant: Olsen et al.

Appl. No.: 10/614,990

Filing Date: July 9, 2004

Title: STANNILOCALCIN POLYNUCLEOTIDES, POLYPEPTIDES AND METHODS BASED THEREON

Attorney Docket No.: PF108P2D1

Pub. No.: US 2004/0198658 A1

Pub. Date: October 7, 2004

This is in response to the request for correction of patent application publication under 37 CFR 1.221(b), which was filed on December 6, 2004.

The request is DISMISSED.

Applicant requests the application be republished because the patent application publication is alleged to contain material mistakes, as it fails to include claims 2-15, 33-47, 49-62, 64-67, 79-102, 104-120 and 122-138, as were originally filed in the application. Applicant states that the publication appears to be based on the preliminary amendment filed June 23, 2004 and failed to publish the claims as originally filed in compliance with 37 CFR 1.215, as the amendment to the rule did not go into effect until October 21, 2004. Applicant argues that the failure to publish these claims as originally filed is material error affecting the scope of the provisional rights that the applicant may seek to enforce upon issuance of the patent.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records . . . This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.¹

¹Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

On June 23, 2004, applicant filed a response to a restriction requirement, which canceled and amended some of the claims, which were originally filed in the application. On October 7, 2004, the Office published the patent application with the claims as amended on June 23, 2004.

The patent application publication does not include a mistake in the publication by the Office because a patent application publication may include a preliminary amendment. While applicant argues that the changes to 37 CFR 1.215(a) published in the Federal Register on September 21, 2004 did not go into effect until October 21, 2004, the amendments to 37 CFR 1.215(a) were a codification of the current Office practice. The Office changed the procedures for publication of patent applications so as to publish applications as amended and waived the provisions 37 CFR 1.215(a) to the extent that they were inconsistent with this change in practice. See Patent Application Publications May Now Include Amendments, 1281 Off. Gaz. Pat. Office Notices 53 (April 13, 2004).

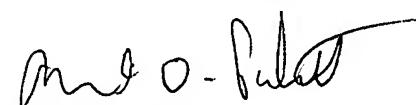
Applicant's request for a corrected patent application publication on December 6, 2004, may constitute a "failure to engage in reasonable efforts to conclude processing or examination of the application." See 1.704(c). This determination will be made on or after a mailing of a Notice of Allowance.

The applicant is advised that the canceled claims can be published, if an amendment is filed adding the claims and paying the appropriate fee, a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

Any request for republication under 37 CFR 1.221(b), must be submitted via the EFS system and questions or request for reconsideration of this decision, should be addressed as follows:

By mail to: Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Inquiries relating to this matter may be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).



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